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6449 7590 01/29/2008 ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005				
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* AMY HAUGEN and KEVIN ROWNEY  
9

10  
11 Appeal 2007-4201  
12 Application 09/637,387  
13 Technology Center 3600  
14

15  
16 Decided: January 25, 2008  
17  
18

19 *Before* WILLIAM F. PATE, III, HUBERT C. LORIN, and ANTON W.  
20 FETTING, *Administrative Patent Judges*.

21  
22 PATE, III, *Administrative Patent Judge*.

23  
24 DECISION ON APPEAL

25  
26 STATEMENT OF CASE

27 The Appellants appeal under 35 U.S.C. § 134 (2002) from a Final  
28 Rejection of claims 3-15 and 30. Claims 1-2 were previously canceled while  
29 claims 16-29 stand withdrawn from consideration. Therefore, only claims 3-  
30 15 and 30 are presented for appeal. We have jurisdiction under 35 U.S.C.  
31 § 6(b) (2002).

1 The Appellants claim a redemption system and method for a network  
2promotion system that provides awards to consumers for participation in  
3promotion programs. In accordance with the invention, when a request for  
4redemption of an award is made, an authentication level required from the  
5consumer for redemption is determined based on award transaction  
6information.

7 Independent claims 3 and 10 read as follows:

8 3. A redemption method for use with a network promotion  
9 system that provides awards to consumers for participation in  
10 promotion programs, the method comprising the steps of:  
11 receiving at a client-user device award transaction information  
12 describing awards earned by the consumers for participation in the  
13 promotion programs of the network promotion system;  
14 maintaining the award transaction information in a transaction  
15 history database of a promotion server device, the promotion server  
16 device being communicable with the client-user device over a  
17 network;  
18 receiving a request from a selected consumer using a client-user  
19 device to redeem at least a portion of the awards earned by the  
20 selected consumer; and  
21 determining an authentication level required from the selected  
22 consumer to redeem the at least a portion of the awards, the  
23 authentication level being determined from the award transaction  
24 information stored in the transaction history database of the promotion  
25 server device.

26  
27 10. A redemption system for use with a network promotion  
28 system, wherein the network promotion system provides awards to  
29 consumers for participation in promotion programs, the redemption  
30 system comprising:

1           a transaction history database for storing award transaction  
2           information that describes the awards earned by the consumers for  
3           participation in the promotion programs of the network promotion  
4           system; and  
5           a processor coupled to the transaction history database and  
6           operable to perform the steps of:  
7                receiving a request from a selected consumer to redeem  
8                at least a portion of the awards earned by the selected consumer  
9                that are included in the transaction history database; and  
10              determining an authentication level required from the  
11              selected consumer to redeem the at least a portion of the  
12              awards, the authentication level being determined from the  
13              award transaction information associated with the selected  
14              consumer and maintained in the transaction history database.

16  
17           Independent claim 13 recites a redemption system in a means plus  
18function format.

19           The prior art relied upon by the Examiner in rejecting the claims is:

20                Biorge                      5,806,045                      Sep. 8, 1998

21  
22           The Examiner rejected claims 3-15 and 30 under 35 U.S.C. § 102(b)  
23as anticipated by Biorge.

24           We REVERSE.

25

26                                              ISSUE

27           The sole issue raised in the present appeal is whether the Appellants  
28have shown that the Examiner erred in rejecting claims 3-15 and 30 as  
29lacking novelty over Biorge.

1  
2 FINDINGS OF FACT

3 The record supports the following findings of fact (FF) by a  
4preponderance of the evidence.

5 1. Biorge discloses a redemption system 70 for use with a network  
6promotion system, wherein the network promotion system provides awards  
7to consumers for participation in promotion programs (Fig. 3; Col. 3, ll. 52-  
858; Col. 4, ll. 29-41).

9 2. Biorge discloses that the redemption system comprises a  
10transaction history database 102, 116 for storing award transaction  
11information that describes the awards earned by the consumers for  
12participation in the promotion programs of the network promotion system  
13(Fig. 3; Col. 6, ll. 44-48; Col. 15, ll. 2-27).

14 3. Biorge also discloses a processor 100 coupled to the transaction  
15history database 102 and operable to receive a request from a selected  
16consumer to redeem at least a portion of the awards earned by the selected  
17consumer that are included in the transaction history database (Figs. 2 and  
184b; Col. 7, ll. 1-6; Col. 9, ll. 26-36; Col. 12, ll. 38-50; Col. 13, ll. 3-13).

19 4. Biorge further discloses that the processor determines an  
20authentication level required from the selected consumer to redeem the at  
21least a portion of the awards (Col. 11, ll. 9-20).

22

1 PRINCIPLES OF LAW

2 “A claim is anticipated only if each and every element as set forth in  
3the claim is found, either expressly or inherently described, in a single prior  
4art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d  
5628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987). Analysis of  
6whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins  
7with a determination of the scope of the claim. We determine the scope of  
8the claims in patent applications not solely on the basis of the claim  
9language, but upon giving claims their broadest reasonable construction in  
10light of the specification as it would be interpreted by one of ordinary skill in  
11the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir.  
122004). The properly interpreted claim must then be compared with the prior  
13art. In construing means-plus-function claim language in accordance with  
1435 U.S.C. § 112, ¶ 6, one must “look to the specification and interpret that  
15language in light of the corresponding structure, material, or acts described  
16therein, and equivalents thereof, to the extent that the specification provides  
17such disclosure.” *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193 (Fed. Cir.  
181994).

19

20 ANALYSIS

21 The Appellants argue that Examiner’s rejection of claims 3-15 and 30  
22as lacking novelty over Biorge should be reversed because Biorge fails to  
23disclose several different limitations recited in the various independent  
24claims. In particular, the Appellants argue that Biorge fails to disclose the

1step of “maintaining the award transaction information in a transaction  
2history database of a promotion server device” because all of the transaction  
3information is stored in the handheld customer device and not stored in the  
4base device as asserted by the Examiner (App. Br. 7, ll. 10-App. Br. 9, l. 25).  
5The Appellants’ assertion is without merit because as noted by the  
6Examiner, Biorge clearly discloses that the transaction information is stored  
7in the memory 102, 116 of the base device 72 (FF 2; Ans. 18, ll. 5-20). The  
8fact that Biorge also stores and uses the same transaction information in the  
9customer device 74 does not detract from the fact that the transaction  
10information is stored in the base device.

11       The Appellants further argue that Biorge does not disclose the step of  
12“determining an authentication level required from the selected consumer to  
13redeem the at least a portion of the awards, the authentication level being  
14determined from the award transaction information stored in the transaction  
15history database of the promotion server device” (App. Br. 9, l. 26-App. Br.  
1610, l. 3). We disagree with the Appellants’ initial argument that Biorge fails  
17to disclose “determining an authentication level required from the selected  
18consumer” because Biorge does disclose authentication of the user by entry  
19of a user code (App. Br. 10, ll. 4-17; Reply Br. 1, 16-Reply Br. 2, l. 30; FF  
204; Ans. 19, ll. 5-9). The Appellants’ arguments that the Appellants’  
21invention determines “authentication levels”, and that the level of  
22authentication in Biorge does not vary “fail from the outset because, . . . they  
23are not based on limitations appearing in the claims . . .” *In re Self*, 671  
24F.2d 1344, 1348 (CCPA 1982) (App. Br. 10, ll. 4-17; Reply Br. 1, 16-Reply

1Br. 2, l. 30). The rejected claims do not recite “authentication levels” but  
2instead, merely recite “an authentication level” which is satisfied by the  
3disclosed authentication step of Biorge (FF 4; Ans. 19, ll. 4-5). The  
4authentication of a user by entry of a user code is a level of authentication  
5that was determined in Biorge, and the fact that this level of authentication is  
6predetermined and not variable does not detract from the fact such  
7authentication meets the recited claim limitation.

8        Nonetheless, we do agree with the Appellants that the user code used  
9in the authentication step of Biorge is not stored in a “transaction history  
10database of the promotion server device” (App. Br. 10, ll. 18-21). Thus, we  
11agree with the Appellants that Biorge does not disclose “the authentication  
12level being determined *from the award transaction information* associated  
13with the selected consumer and *maintained in the transaction history*  
14*database*” as recited in independent claim 3 (emphasis added) (App. Br. 10,  
15ll. 22-26). Correspondingly, we also agree that Biorge does not disclose  
16“the authentication level being determined *from the award transaction*  
17*information* associated with the selected consumer and *maintained in the*  
18*transaction history database*” as recited in independent claim 10 (emphasis  
19added) (App. Br. 11, ll. 1-3). Biorge also does not disclose a “means for  
20determining *from the award information in the transaction history database,*  
21an authentication level required” as recited in independent claim 13, the  
22recited means being interpreted to refer to the disclosed promotions server  
23218 having a transaction history database 116 and a processor 234 for  
24executing the consumer authentication mechanism, and equivalents thereto



1(emphasis added) (App. Br. 11, ll. 1-3; Spec. 10, ll. 22-29; Spec. 11, l. 20-  
2Spec. 12, l. 5; Spec. 14, ll. 7-19).

3       Therefore, the Appellants have shown that the Examiner erred in  
4rejecting independent claims 3, 10 and 13 as lacking novelty over Biorge.  
5Claims 4-9, 11, 12, 14, 15 and 30 ultimately depend from one of the  
6independent claims 3, 10 or 13 discussed *supra*. Thus, the Appellants have  
7also shown that the Examiner erred in rejecting these dependent claims.

8

9                               CONCLUSION and ORDER

10       The Appellants have established that the Examiner erred in rejecting  
11claims 3-15 and 30 as anticipated by Biorge, and thus, the rejection is  
12REVERSED.

13

14

REVERSED

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17

18

19JRG

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